

TTAB

LAW OFFICES

**BALLARD SPAHR ANDREWS & INGERSOLL, LLP**

1735 MARKET STREET, 51ST FLOOR  
PHILADELPHIA, PENNSYLVANIA 19103-7599  
215-665-8500  
FAX: 215-864-8999  
WWW.BALLARDSPAHR.COM

BALTIMORE, MD  
DENVER, CO  
SALT LAKE CITY, UT  
VOORHEES, NJ  
WASHINGTON, DC  
WILMINGTON, DE

ROBERTA JACOBS-MEADWAY  
DIRECT DIAL: 215-864-8201  
PERSONAL FAX: 215-864-9950  
JACOBSMEADWAYR@BALLARDSPAHR.COM

December 22, 2005



Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

12-30-2005

U.S. Patent & TMO's/TM Mail Rpt Dt. #11

Re: Saint-Gobain Corp. v. Minnesota Mining & Manufacturing Co. a/k/a 3M  
Company  
Opposition No. 119,166  
Our file: 884233

75.488, 524

Dear Madam:

On behalf of Saint-Gobain Corporation, we are enclosing herewith a redacted copy of Opposer's Reply Brief to be filed with the Trademark Trial and Appeal Board.

Please also find enclosed an unredacted original copy of Opposer's Reply Brief and Exhibits thereto submitted in sealed envelopes under separate cover to be filed under seal.

Respectfully submitted,

*Roberta Jacobs-Meadway*  
Roberta Jacobs-Meadway

RJM/  
Enclosures

cc: Roberta Horton, Esquire (via overnight mail)  
Saint-Gobain Corporation

REDACTED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SAINT-GOBAIN CORPORATION

*Opposer,*

v.

Opposition No. 119,166

MINNESOTA MINING AND MANUFACTURING  
COMPANY a/k/a 3M COMPANY

*Applicant.*

OPPOSER'S REPLY BRIEF

ROBERTA JACOBS-MEADWAY  
BERNADINE J. MUNLEY  
BALLARD SPAHR ANDREWS &  
INGERSOLL, LLP  
1735 MARKET STREET  
51<sup>ST</sup> FLOOR  
PHILADELPHIA, PA 19103-7599  
(215) 665-8500

ATTORNEYS FOR OPPOSER

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR TRADEMARKS, P.O. BOX 1451, ALEXANDRIA VA 22313-1451 ON THE DATE INDICATED BELOW

By: 

DATE: 12/22/05

## INDEX OF CASES

<i>American Home Products v. Johnson &amp; Johnson</i> , 436 F. Supp. 785 (S.D.N.Y. 1977), <u>aff'd</u> , 577 F.2d 160 (2nd Cir. 1978) .....	8
<i>American Scientific Chemical, Inc. v. American Hospital Supply Corp.</i> , 690 F.2d 791 (9th Cir. 1982).....	10
<i>British Seagull Ltd. v. Brunswick Corp.</i> , 28 U.S.P.Q. 2d 1197 (TTAB 1993), <u>aff'd</u> , 35 F.3d 1527 (Fed. Cir. 1994).....	5
<i>Brunswick Corp. v. British Seagull Ltd.</i> , 35 F.3d 1527 (Fed. Cir. 1994) .....	14, 18
<i>Curtice-Burns, Inc. v. Northeast Sanitation Products, Inc.</i> , 185 U.S.P.Q. 61 (TTAB 1975), <u>aff'd</u> , 530 F.2d 1396 (C.C. PA. 1976).....	3
<i>In re Ferris Corp.</i> , 59 U.S.P.Q. 2d 1587 (TTAB 2001) .....	5, 14-15, 18
<i>Flowers Industrial Inc. v. Interstate Brands Corp.</i> , 5 U.S.P.Q. 2d 1580 (TTAB 1987) .....	12
<i>In re Howard S. Leight and Associate</i> , 39 U.S.P.Q. 2d 1058 (TTAB 1996).....	14-15, 18
<i>Kasco Corp. v. Southern Saw Service Inc.</i> , 27 U.S.P.Q. 2d 1501 (TTAB 1993) .....	18
<i>Minnesota Mining &amp; Manufacturing Co. v. Beautone Specialties, Co., Ltd.</i> , 82 F. Supp. 2d 997 (D. Minn. 2000) .....	2, 9
<i>In re Owens-Corning Insulation Corp.</i> , 774 F.2d 1116 (Fed. Cir. 1985).....	14, 19
<i>Pharmacia Corp. v. Alcon Laboratories, Inc.</i> , 201 F. Supp. 2d 335 (D.N.J. 2002).....	9
<i>President Trustees of Colby College v. Colby College</i> , 508 F.2d 804 (1st Cir. 1975) .....	8
<i>R.L. Winston Rod Co. v. Sage Manufacturing Co.</i> , 838 F. Supp. 1396 (D. Mon. 1993).....	18, 19
<i>Spraying Systems Co. v. Delavan, Inc.</i> , 762 F. Supp. 772 (N.D. Ill. 1991).....	19
<i>Tyco Industrial Inc. v. Lego System Inc.</i> , 5 U.S.P.Q. 2d 1023 (D. N.J. 1987), <u>aff'd</u> , 853 F.2d 931 (3rd Cir. 1988) .....	9

## **I. PRELIMINARY STATEMENT**

3M seeks to register some shade of purple for nearly all coated abrasive products as a trademark. 3M has not met its burden to establish that any purple color has acquired distinctiveness and is not functional.

SG has presented substantial evidence that 3M's purple color has not acquired and can not acquire distinctiveness, and that 3M's color is functional. This evidence includes, *inter alia*, a survey prepared by a well-qualified expert directed to the issue of distinctiveness; expert testimony directed to the issue of functionality; and third party evidence directed to the issues of distinctiveness and functionality.<sup>1</sup>

In response, 3M puts forward scant evidence. It offers no survey, although it has done surveys in the past to establish distinctiveness of a color. It offers no meaningful expert testimony on distinctiveness or functionality. Its only direct evidence on the issue of distinctiveness, beyond its employees' self-serving testimony, is the testimony of four isolated individuals, two of whom work in niche markets, and none of whom is an expert qualified to speak to the impressions of others in the industry or of purchasers generally. 3M's indirect evidence of distinctiveness is likewise insufficient, and is predicated on exaggeration, misstatement, hearsay and inconsistencies.

3M spends considerable time and effort to attack SG's statements of fact, without offering any evidence to contradict the operative facts: the prior and continuous use by SG and others of the purple color and very similar shades for the same types of coated abrasives and closely related coated abrasives; the impact of the use of phenolic resins on the color of the coated abrasives; the need to use dark colors to mask streaking and other visual defects; and the use of color-coding in the industry to signify grit and application.

---

<sup>1</sup> The testimony of SG's experts Mr. Freese (on manufacturing of coated abrasives) and Dr. Rosen (on color and color measurement) is uncontroverted by 3M, who produced no expert testimony on such matters.

When the Board weighs the scant evidence presented by 3M against the quality and quantity of SG's evidence, it will be clear that 3M has not met its burden of establishing acquired distinctiveness and non-functionality. The application for registration should accordingly be rejected.

## **II. ARGUMENT**

### **A. 3M APPLIED THE WRONG TEST FOR ACQUIRED DISTINCTIVENESS AND THEREFORE DOES NOT REACH THE CORRECT CONCLUSION**

#### **1. 3M's Asserted Direct Evidence That Individuals In The Relevant Markets Exclusively Recognize 3M's Alleged Purple Mark As A Source Indicator Is Deficient.**

3M chose not to provide the most persuasive type of direct evidence available in support of a claim of acquired distinctiveness, namely a survey. 3M is not adverse to surveys, and obviously has the financial resources to have conducted one. In fact, 3M cites in its acquired distinctiveness section a case where it established acquired distinctiveness in the canary yellow for its POST-IT® products based predominantly on survey evidence. See, Minnesota Mining & Mfg. Co. v. Beautone Specialties, Co., Ltd., 82 F. Supp.2d 997, 1003 (D. Minn. 2000). 3M has argued in this case that it has provided significant direct evidence of customers' association between the 3M purple mark and 3M. (3M Trial Brief 14-15, hereafter cited as "3M TB"). The evidence 3M refers to consists not of a survey, but only four individuals who do business with 3M and claim they associate the color purple with 3M's coated abrasives.

3M asks the Board, without any supporting legal authority, to conclude that there is direct evidence that 3M's alleged purple mark has acquired distinctiveness in all the relevant trade and geographic markets where coated abrasives are sold based on the non-expert testimony of four hand-picked individuals.<sup>2</sup> The non-expert testimony of a few third party witnesses concerning their recognition of a mark is wholly inadequate to prove the mark's recognition in the entire relevant market.

---

<sup>2</sup> In footnote 8 of 3M's Trial Brief, 3M informs the Board that it is offering the testimony of its four third party witnesses instead of the form customer statements it previously relied on as direct evidence of acquired distinctiveness. Given 3M's implied abandonment of the form customer statements as evidence, SG sees no need to address them further.

Curtice-Burns, Inc. v. Northeast Sanitation Prods., Inc., 185 U.S.P.Q. 61, 62 (TTAB 1975), aff'd, 530 F.2d 1396 (C.C.P.A. 1976). Non-experts, such as 3M's third party witnesses, are incapable of testifying as to the opinions of others. Id. The testimony is restricted to each of the testifying witnesses' own perception. Id. This type of third party testimony represents something far less than a *de minimis* statistical percentage of the relevant markets at issue.

None of the four individuals were offered as experts. Their testimony is not part of nor based on any properly conducted survey. Yet, 3M puts forth the testimony of these four individuals and asks the Board, without any case citation, to make the dazzling inference that this is credible direct evidence of acquired distinctiveness. The conclusion the Board should and must draw is that the testimony represents the perception of only those four people. Curtice-Burns, 185 U.S.P.Q. at 62. Given that 3M's application is not limited to specific trade or geographic markets for its coated abrasives, the testimony of four individuals who are clearly not representative of the wide variety of markets across the U.S. in which the products are sold, is far too insignificant to warrant any conclusion as to market-wide source recognition of 3M's alleged purple mark.

While 3M would like the Board to accept the four individuals as market giants, this would be a mischaracterization. Tom Kelley operates a small family business of 11 individuals in a geographic market limited to the Syracuse area (Kelley Test. Dep. at 30-33, herein attached as Exhibit A). Paul Wimer, who has only been in the hardwood flooring industry for five years, is a general manager of a small family business with 25 employees in the Washington D.C./Baltimore area (Wimer Test. Dep. at 9, 59, 63, herein attached as Exhibit B). Sprigg Lynn runs a small family business in Washington D.C., and a majority of the company's work is done within five miles of the company's shop (Lynn Test. Dep. at 10, 63, herein attached as Exhibit C). Charlie Hutton is a sole proprietor in Idaho who works in the very specialized market of hot rod race cars, and on average works on about 12 cars a year, spending only about \$2,500 for 3M coated abrasive products per car (Hutton Test. Dep. at 9, 53, 56, herein attached as Exhibit D). Even if the Board were inclined to credit the substantive testimony of these individuals, none

has the market presence and recognition that overcomes the quantitative insignificance of the testimony of four individuals and the lack of survey evidence.<sup>3</sup>

3M, in essence, asks the Board to give more weight to its four hand-picked witnesses than SG's credible survey evidence based on 600 interviews. (SG TB Ex. 42). The Board should not be distracted by 3M's five-page dissertation regarding the credentials of these individuals, none of whom was identified as an expert by 3M. In the end, regardless of their respective positions, they are still just four people who do business with 3M and who have no basis to comment on the perceptions of others.

In a further effort to maneuver around its lack of survey evidence, 3M argues that the link between the alleged purple mark and itself "is also obvious in customer's ordering habits." (3M TB 19). 3M offers no survey or other quantitative evidence to support this allegation. Instead, it offers the testimony of Messrs. Hutton, Doeksen, and Lain, and only one of these three is a customer. 3M's proclamation that only color and grit size is given when customers place orders for 3M coated abrasives is not credible, and the evidence on which 3M relies does not support its baseless claim. First, 3M ignores the weight of the evidence in the record, including its own documents, that more than just color and grit are needed to order 3M's coated abrasives. (3M TB Ex. 7, 3M 00132). The absurdity of 3M's claim that its product is ordered by grit and color alone is demonstrated by the chart in 3M's Automotive Aftermarket Catalog (DeNuccio Test. Dep., Ex. 9, attached herein as Exhibit E) which shows that for "purple, 80 grit" there are 19 different products, each having a different part number. 3M's product is ordered by part number.

---

<sup>3</sup> In footnote 10 of its Trial Brief, 3M addresses the testimony of its expert, Mr. Turbyfill. Mr. Turbyfill was put forward as an alleged expert in the furniture business only (SG TB Ex. 47 at 1). He is not offered, nor qualified, to testify as to opinions of others regarding recognition of 3M's alleged purple mark as a source indicator. Mr. Turbyfill himself even misidentified a Moyco paper-backed coated abrasive for a 3M product (SG TB App. 8 at 67). His testimony that "he recognized deep, dark purple sandpaper products as coming from 3M" (3M TB 17) is limited to his own perception, and at best gives 3M five individuals instead of four as the basis of 3M's direct evidence.

3M relies on the testimony of two distributors who claim that orders come in from customers in a variety of ways such as "fax, email, phone, or in-person," and claims this evidence shows that customers order by color and grit alone (3M TB 20). 3M's problem, which it cannot surmount, is that this is hearsay, and there is no such documentary evidence. There are no faxes and no emails in the record. No such evidence was included as an exhibit to 3M's Trial Brief. At no time during the five years of this proceeding has 3M or any other entity produced a single order, fax, email, phone record, or any other form of any sort showing a 3M coated abrasive ordered by color and grit alone. Any testimony or reference related to such alleged evidence is at best hearsay, and should be excluded from the Board's consideration.

Even assuming there existed some admissible evidence that some few customers (other than Mr. Hutton, who is a special case, see *infra* p. 21) had placed orders for 3M products by color and grit only, such evidence would be inconclusive. Without inquiring into the customers' perceptions, it is impossible to know if the customers were ordering by color because they viewed it as a source indicator, or simply as descriptive of the color of the product. See, e.g., British Seagull Ltd. v. Brunswick Corp., 28 U.S.P.Q.2d 1197, 1202 (TTAB 1993) aff'd, 35 F.3d 1527 (Fed. Cir. 1994); In re Ferris Corp., 59 U.S.P.Q. 2d 1587, 1592 (TTAB 2001). That is, someone might conceivably try to place an order for a box of purple discs and a box of gold discs. Given the lack of source recognition evidence, the Board has no basis to assume that any such order would evidence the use of color as a trademark. The assumption is at least as logical that such customers were simply ordering using color to describe one visual aspect of the 3M product, along with form and grit.

Likewise, in a weak attempt to use obvious hearsay testimony in place of direct evidence, 3M begins its "fact" section of its brief by citing to an "encounter" between Carl Doeksen and Norm Abram of the television show "This Old House." (3M TB 6). Incredibly, 3M relies upon hearsay statements alleged to have been made by this television personality as the basis for the development of its purple products, and the foundation for an argument of acquired distinctiveness. While this makes interesting reading, it is certainly not evidence that can be relied upon by this Board.



## **2. 3M's Critique of SG's Survey Evidence Is Factually Flawed.**

3M takes the position that SG's survey "suffers from several problems," and so should not be considered by the Board as evidence that 3M's alleged purple mark has not acquired distinctiveness. (3M TB 21). 3M failed to provide any survey evidence of its own even when it had ample opportunity to conduct a rebuttal survey and it conducted surveys in past cases, which undermine 3M's critique. If 3M thought it could design a better survey, it failed to do so. Regardless, 3M's criticism is misguided at best. SG's survey evidence is sound and relevant and should be considered and given much weight by the Board.

3M argues, apparently in some attempt to use SG's survey evidence for its own advantage, that many of the survey respondents associated 3M's alleged purple mark uniquely with 3M (3M TB 21). Given the overall results of the survey, 3M's assertion is wholly unfounded. See, British Seagull, 28 U.S.P.Q. 2d at 1202-1203. 3M's reliance on a few individuals who associated purple with 3M is misplaced given the overall results of the survey. Almost as many associated the color orange with 3M, and many associated purple with 3M and others, confirming that purple is used descriptively rather than as a trademark (See SG TB Exs. 42, 43). Others associated purple with SG's entities, not 3M (SG TB Ex. 42). Further, the color purple was recognized as describing coated abrasives coming from various sources (SG TB Ex. 42). The color was also recognized as having various functional attributes. (See SG TB Ex. 42). As the survey results show: "to the extent that color has a meaning in sandpaper, at least using the purple and orange examples, it has more to do with function than source." (Phil Johnson Disc. Dep. at 146, herein attached as Exhibit F); See, e.g., Survey Response Johnson 1409 (As one respondent stated: "because I'm familiar with Scotch pads. I know white is superfine, green is fine, purple is medium and brown is coarse. At least, I think so.") (SG TB Ex. 43). There is, as demonstrated, no trademark significance to the color purple.

3M criticizes SG's survey on the basis that it was done by telephone, and the respondents were not shown 3M's alleged color purple mark (3M TB 6). This criticism is simply wrong. In the circumstances of this case, where the alleged mark appears in many different forms, on many different

products, having different appearances in context, and dependant on grit, the only proper way to test whether there was any acquired distinctiveness associated with 3M's color purple was to ask about the color, and a control. (SG TB, Ex. 42 at 5). Any stimulus shown would arguably be misleading to some of the respondents as not representative of a product he or she had seen, if the respondent had ever seen any product of 3M that was any purple shade. (See Phil Johnson Rebuttal tr. at 17-18, herein attached as Exhibit G). Any one product that Mr. Johnson might have shown would have been criticized by 3M as not being the right grit, form or product.<sup>4</sup> The telephone methodology was proper under the circumstances.

The use of "purple" (and "orange") as the stimulus was proper, giving 3M the greatest chance of showing some acquired distinctiveness. If a respondent were familiar with the light-appearing stearate product, or the reddish-purple 745I product or the 930DZ product, the respondent could express awareness of a purple 3M product, and be counted as having identified 3M as a source of purple product. (Exhibit F at 67-75; SG TB, Ex. 43 at 17-20). Even with this advantage, the recognition of 3M as the source of purple product was low, and the single source identification was lower still. (Exhibit F at 183-4). There is no acquired distinctiveness.

Criticism of the use of the oral "purple" as a stimulus by 3M is based on demonstrable error. 3M's expert cited a number of articles in an effort to show that use of an oral stimulus was improper. (Exhibit G at 6-17; Johnson Test. Dep., Exs. 685-688, herein attached as Exhibit I). A reading of those articles does not support 3M's position. The articles, in fact, are neutral on the point or supportive of the use of the oral stimulus in the circumstance of this case. (Exhibit G at 6-17; Exhibit I). See, e.g., the Childers and Houston article, SG 686, where the authors state: "Only in the case of interactive pictures was the learning of pictures superior to words.") (Exhibit I). Here, there would be nothing interactive in the presentation of a piece of purple coated abrasive paper. (Exhibit G at 25-26, 40-43).

---

<sup>4</sup> See SG TB Ex. 9 for the range of purple shades of 3M's coated abrasives; See also, "Purple" Products 3M Alleges Are Covered By Its Application herein attached as Exhibit H.

Because the articles and testimony about the articles 3M sought to rely on were shown to be not on point at Mr. Johnson's rebuttal deposition, 3M in its brief seeks to rely on an expert who did not testify and who was never consulted on the matter at issue. 3M's new reference to Shari Diamond and its misreading of her work can not render valid a critique that has no validity (3M TB 22). The point Ms. Diamond is making relates to complex trade dress, not a single color. That is, 3M consistently wants to cite to different types of studies done in different types of cases to criticize the study done here. Such criticism has no merit. There is nothing inherently deficient or problematic with telephone surveys, and such surveys are done and commonly relied on. See, President Trustees of Colby College v. Colby Collge, 508 F.2d 804, 809 (1<sup>st</sup> Cir. 1975). Cf., American Home Products v. Johnson & Johnson, 436 F.Supp. 785, 793-795 (S.D.N.Y. 1977), aff'd 577 F.2d 160 (2<sup>nd</sup> Cir. 1978).

3M then seeks to find some other basis to attack SG's survey since Ford's critique has been shown to be based on a misreading of articles and a misuse of those articles (3M TB 22-23). The alternate bases are equally unsound. In footnote 14 of its Trial Brief, 3M argues that a response rate was not reported for the SG survey, and that is "another reason why the results are useless." (3M TB 22-23). "Useless" better describes 3M's argument than anything else, and that is probably why it is buried in a footnote. Mr. Johnson provided the response rate, and 3M questioned him about it at his deposition on February 9, 2005. Mr. Johnson was asked: "how does the 29 percent nonresponse category compare to other nonresponse rates that you've experienced in surveys that you have designed?" (Exhibit F at 92-93), Mr. Johnson testified without contradiction: "It's very low." (Exhibit F at 92-93).

3M's criticism of the screening question is likewise without merit. The screening question was intended to identify respondents familiar with coated abrasives, who said they used the product in connection with their jobs. (Exhibit F at 100-101). A purchasing agent ordering by UPC code might never see the actual product. The screening question, in fact, would work to 3M's advantage, including users who would be aware of its purple products, if there were any awareness of 3M's purple products, as well as purchasers. (Exhibit F at 100-101).

The questions were asked of the appropriate universe: purchasers and consumers of coated abrasives. (Exhibit F at 100-101). A sample of the verbatim responses demonstrates that the right questions were asked of a representative sample of members of the relevant public. (Johnson Test. Dep., Ex. 95 herein attached as Exhibit J). When asked: "How would you describe your job title?", typical responses were: "Industrial supply man." (Exhibit J at 0331); contractor (Exhibit J at 1447); auto body technician (Exhibit J at 1507); foreman at a custom cabinet shop (Exhibit J at 0070).

3M takes pains to argue that survey evidence is not required to prove acquired distinctiveness. The issue is not whether a survey is required of 3M, but the reasons why 3M opted not to conduct a survey. 3M has conducted surveys in past cases to prove a color has acquired distinctiveness. See, Minnesota Mining & Mfg. Co. v. Beautone Specialties Co., Ltd., 82 F.Supp.2d 997, 1003 (D. Minn. 2000). 3M's failure to conduct a survey warrants an inference that 3M believes the results of such a survey would be unfavorable. Pharmacia Corp. v. Alcon Labs., Inc., 201 F.Supp. 2d 335, 373 (D.N.J. 2002). Further, a critique of a survey with no survey is unconvincing. Tyco Indus. Inc. v. Lego Sys. Inc., 5 USPQ 2d 1023, 1031 (D. N.J. 1987), aff'd 853 F.2d 931 (3<sup>rd</sup> Cir. 1988).

Its lack of survey evidence is a glaring point that 3M cannot escape, especially when 3M has used surveys in the past in connection with similar cases dealing with alleged color marks.

### **3. 3M's Circumstantial Evidence Is Equally Unpersuasive.**

Recognizing the insufficiency of its direct evidence, most notably its total lack of survey evidence, 3M focuses the thrust of its acquired distinctiveness argument on circumstantial evidence. Unfortunately for 3M, its circumstantial evidence falls well short of permitting any inference of acquired distinctiveness to be drawn. Circumstantial evidence is of limited value in support of a claim for acquired distinctiveness without direct evidence to show how the relevant market perceived the mark in question. Circumstantial evidence is particularly weak where, as here, others have long used the same and similar shades for the same and closely related goods.

To support its claim that it has provided significant circumstantial evidence of acquired distinctiveness, 3M relies on American Scientific Chemical, Inc. v. American Hospital Supply Corp., 690

F.2d 791, 793-94 (9<sup>th</sup> Cir. 1982). 3M states that “among other things, the American Scientific court cited the fact that the plaintiff sent representatives to trade shows, was known in the industry, and employed an effective form of advertising in its reliance on personal contact as indicia that the ‘American Scientific’ name enjoyed secondary meaning.” (3M TB 24-25). The “among other things” language in 3M’s brief refers to the reliance in American Scientific on the following to establish secondary meaning: use of the name for over thirteen years; a specialized market; a specialized service; 149 purchase orders addressed to “American Scientific;” and 28 examples of correspondence from suppliers addressed to “American Scientific.” American Scientific 690 F.2d at 793. Here, 3M does not compete in a specialized, close-knit market. Industry-wide sales of coated abrasives are in the billions of dollars (SG TB Ex. 1 at 4). Despite 3M’s claim that purchasers order product by color, it has produced no purchase orders to that effect. If, as 3M suggests, American Scientific sets the bar for what indirect evidence may establish acquired distinctiveness, 3M’s evidence falls well short of it.

3M asks the Board to infer acquired distinctiveness as a result of 3M’s promotional efforts and sales figures. However, 3M’s promotional efforts and sales are not so significant as to warrant any such inference, especially in the circumstances of this case. Any evidence of sales or promotional efforts not related to 3M’s 961UZ product or products identical to the “deep” purple color of the 961UZ product must be ignored as irrelevant. For circumstantial evidence such as sales figures and promotional efforts to be given any weight in an acquired distinctiveness analysis, the evidence must relate *directly* to the alleged mark at issue. See, Waldman Lighting Co. v. Halogen Lighting Sys., Inc., 28 U.S.P.Q.2d 1682 1684-85 (N.D. Ill. 1993). Circumstantial evidence is of no value when it cannot be attributed to the mark at issue, such as where the evidence relates to more than one mark or brand.

In the present case, 3M purports to be quite frank in its Trial Brief as to what shade of purple it is trying to protect in its application: “it is the particular color displayed on the sandpaper specimen submitted with 3M’s original application, the 961UZ product.” (3M TB 32). This of course directly contradicts 3M’s interrogatory answers, where it said the application covered ten different products (SG TB Ex. 16). In its introduction, 3M refers to it as: “one distinctive shade of deep purple.” (3M TB 1).

While SG continues to dispute 3M's multiple descriptions of its alleged purple mark, 3M's attempted modifications of its mark are self-destructive to its use of any of its asserted circumstantial evidence.

A look at 3M's asserted sales and advertising figures is illustrative. 3M touts \$ [REDACTED] dollars in sales in 2000 attributed to coated abrasives it claims are covered by the application. (3M TB 26). These "covered" products include products not the identical color of 3M's 961UZ specimen which it says defines the color it claims.<sup>5</sup> The only 3M product identical in color to the 961UZ is the Imperial 3M Fibre Disc. Although visually different from the 961UZ, the 930DZ and 761D are arguably close to the color of the 961UZ. Clearly, the other products 3M claims to be covered by the application, the 740I, 745I 752I, 900DZ, and 970DZ, are not the same shade of "deep" purple as the 961UZ specimen. See attached Exhibit H comparing these with the 961UZ product. These products which are not the same shade as the 961UZ account for over \$ [REDACTED] of the \$ [REDACTED] of claimed sales in 2000, and so cannot be considered as evidence of acquired distinctiveness. (Doeksen Test. at 96-98, 3M TB App. 1). The products arguably covered, i.e., 961UZ, Imperial 3M Fibre Disc, 930DZ, and 761D, account for only \$ [REDACTED] of the \$ [REDACTED] 3M claims. (Doeksen Test. at 89, 3M TB App. 1).

In the context of the coated abrasives market for 2005 of \$4.5 billion (SG TB Ex. 1), and in the context of SG's own purple coated abrasive sales in 2000 of \$ [REDACTED] (see SG TB Ex. 3 at SG 01693), 3M's \$ [REDACTED] in sales of coated abrasives that are identical (or at least close) to that of its application specimen, is simply not large enough to warrant an inference of nationwide acquired distinctiveness across all markets. Further, it is telling that 3M relies on no figures after 2000, except for products sold by the CHIM division, where color coding is a prominent feature. (3M TB 26).

<sup>5</sup> 3M only measured one 961UZ sample. The 761D samples measured ranged in hue angle from 283.4 to 291.7. The 930DZ samples measured ranged in hue angle from 282.2 to 289.7. 3M's manufacturing processes are not precise enough for 3M to produce a product having a single consistent shade. (SG TB, Ex. 30).

3M finds itself with the same problem as to its promotion and marketing efforts.<sup>6</sup> There is no doubt that 3M sells coated abrasive products in various shades of purple. There is no doubt that 3M's promotional legend and other marketing efforts make no reference to any specific shade of purple. Rather, the legend reads: "The Color Purple Is A Trademark Of 3M." (SG TB Ex. 9). There is no doubt that 3M has applied this legend to coated abrasives of widely different shades of purple. (SG TB Ex. 9). Since 3M's promotional efforts are not limited to its "deep" purple shade, and it sells multiple coated abrasives of different shades of purple, the Board must conclude that there is no way to attribute any of 3M's promotional efforts and sales to those specific products consisting of the "deep" purple shade. With no concrete connection between the circumstantial evidence and the alleged mark, the evidence must be wholly discounted as purely speculative.

**4. 3M Has Failed To Prove Substantially Exclusive Use Of Its Alleged Color Mark.**

For 3M to successfully make a claim of acquired distinctiveness for its alleged purple mark, it has the burden to prove that it has made substantially exclusive use of the mark. Flowers Indus. Inc. v. Interstate Brands Corp., 5 U.S.P.Q.2d 1580, 1588-89 (TTAB 1987).

SG offered overwhelming evidence in its Trial Brief of third parties and SG selling purple colored coated abrasives. Many of the purple colors used by the third parties and SG are nearly identical in visual appearance to 3M's "deep" purple (See SG TB Exs. 4, 11, 12). Others are very similar. All of the purple colored coated abrasives sold by the third parties and SG are the same types of coated abrasives or closely related to the coated abrasives covered by 3M's alleged purple mark application (SG TB Exs. 4, 11).

In the face of this indisputable evidence, 3M advances a number of meritless arguments in a vain attempt to carve out a market and distinguish its so-called "deep" purple colored products from those of

---

<sup>6</sup> 3M relies heavily on its efforts at a few trade shows where employees wore purple shirts and handed out purple-colored specialty items. Purple shirts and a purple booth at a couple of trade shows fall far short of establishing a national brand strategy. These are transient gimmicks of the sort common in the industry. (SG TB, App. 19 at 19, 31).

SG and others. 3M argues that a number of the third party products at issue are not called "purple," and so should not be considered (3M TB 29-31).<sup>7</sup> It is not the naming of the color, i.e., purplish, maroon, or lavender, that is relevant. 3M is not claiming rights in the color *name*. What matters is how close in appearance those products look to 3M's purple colored products. When the colors used by others are identical or closely similar to 3M's color, it makes no difference how they are described by manufacturers, customers or others, e.g., as black with a purplish hue or purplish. The only material issue is whether individuals in the relevant market would perceive the colors, when not viewed side by side, as being the same or closely similar, and having the same general commercial impression.

3M attempts to dismiss some purple colored products, including SG's, as irrelevant because the products are film-backed coated abrasives, instead of cloth and paper-backed ones specified in 3M's amended application (3M TB 30). The distinction argued by 3M simply does not exist in the relevant markets for coated abrasives, and it can not be rendered relevant for the purpose of determining distinctiveness. Members of the relevant public familiar with "deep" purple film-backed abrasives and similar purple film-backed abrasives would have no reason at all to consider 3M's cloth or paper-backed coated abrasives something distinctive, different, remarkable. When the same purchasers buy film, cloth and paper-backed product, when the same users use film, cloth and paper-backed product, and when 3M itself promotes the film, cloth and paper-backed products together, film product clearly impacts on the perception of any color by persons in the relevant market (SG TB Ex. 9; 3M Auto. Aftermarket cat., Ex. 27 at 3M 4706, 4708; 3M Cabinet Shop cat., Ex. 36 at 3M 0297). 3M has no evidence to the contrary.

#### **B. 3M'S ATTEMPT TO CLAIM COLOR IS NOT DE JURE FUNCTIONAL FAILS**

SG has established de jure functionality of color, including purple, for coated abrasives. 3M's claim that the color purple is not de jure functional is flawed in the first instance because 3M applied an

---

<sup>7</sup> In fact, according to the current operative definition of what constitutes 3M's "purple," coated abrasives which may appear black, including SG's Silicon Carbide product, measure as "purple." (SG TB, Ex. 2 at 8).



erroneous standard for determining whether a feature of a mark, including color, is functional. 3M admits that it uses color, including purple, to code its coated abrasives (3M TB 5). This admission establishes the functionality of its proposed purple trademark. 3M also admits that everyone in the coated abrasives industry dyes their products different colors (3M TB 37), an admission that clearly sets this case apart from In re Owens-Coming Insulation Corp., 774 F.2d 1116 (Fed. Cir. 1985).

**1. 3M Misinterprets the Standard for Finding a Color Functional.**

3M attempts to skew the functionality standard by stating that “the Board should look to the specific facts related to the 3M Purple mark at issue, and ignore SG’s broad generalizations about the coated abrasives industry and the scope of what constitutes ‘purple’.” (3M TB 36). 3M asserts that Brunswick Corp. v. British Seagull Ltd, 35 F.3d 1527 (Fed. Cir. 1994); In re Howard S. Leight and Assocs., 39 U.S.P.Q.2d 1058 (TTAB 1996); and In re Ferris Corp., 59 U.S.P.Q.2d 1587 (TTAB 2001) stand for the proposition that the “3M Purple” cannot be functional unless it is the *only* shade available to manufacturers to conceal imperfections and/or meet the demands of customers. (3M TB 46-48). This analysis is simply wrong. As a matter of law and logic, the industry’s functional use of purple, or any dark color for that matter, renders 3M’s purple functional. Ferris, 59 U.S.P.Q.2d at 1591 (“there is no evidence in the record that competitors use the exact color or shade of ‘pink’ shown on applicant’s specimens for surgical wound dressings. However, the fact that applicant may be the first and only user of this exact color ‘pink’, or that applicant intended the color to serve as trademark does not justify registration of a de jure functional color.”)

In Brunswick Corp. v. British Ltd., 35 F.3d 1527, 32 U.S.P.Q.2d 1120 (Fed. Cir. 1994), the Court reasoned that manufacturers of boat motors seek colors for their boat motors that will easily coordinate with a wide variety of boat colors, and this is a functional use of color. Brunswick, 35 F.3d at 1532. The Court also found that black easily coordinates with a wide variety of boat colors. Id. The color black, therefore, was functional for boat motors. Id. The Court did not hold that only “Brunswick Black” or “Ebony Black” was the only shade of black that would coordinate with a wide variety of boat colors. The

Court held that black, without distinction as to any shade, was a functional color in the boat motor industry. Id.

The Board applied the same reasoning in In re Howard S. Leight and Assocs., Inc., 39 U.S.P.Q.2d 1058 (TTAB 1996), where it found brightly colored earplugs more readily visible, to aid in monitoring employee compliance with safety regulations, and this is a functional use of color. Leight, 39 U.S.P.Q.2d 1060. The Board found the coral color of the applicant's earplugs was a bright color. Id. The color coral, therefore, was functional. Id. Again, the Board did not hold that "Leight Coral" was the only bright color that would aid in monitoring compliance. Id. Indeed, the Board stated "coral earplugs, being closely akin to orange, the color most often used for high visibility, clearly serve to make safety checks easier and quicker." Id. The Board considered that applicant's competitors used other bright colors for the same functional purpose, including fluorescent red, sea foam green, and white. Id. The Board held that coral was *one* of the bright colors that would aid in monitoring employee compliance, and thus was a functional color in the industry. Id.

The Board applied the same reasoning in In re Ferris Corp., 59 U.S.P.Q.2d 1587 (TTAB 2001), on which 3M relies. In Ferris, the Board found that "there is no question that flesh color for wound dressings serves the utilitarian purpose of blending well with the natural color of human skin." Ferris, 59 U.S.P.Q.2d at 1589. The Board also found the pink color of the applicant's wound dressings was a flesh color. Id. at 1590. The color pink, therefore, was functional for wound dressings. The Board did not hold that only "Ferris Pink" or "Hot Pink" was functional. The Board held that although no competitors used the *exact* shade of pink for which the applicant was applying, applicant's pink was "the same or closely resembles the limited range of 'flesh colors' defined by authorities and used by competitors." Id. at 1590-91.

Here the same rationale applies. Dyeing coated abrasives a dark color has the functional use of concealing imperfections like cracking and streaking. (SG TB App. 6 at 24, 41). Purple is a dark color. 3M's purple color, therefore, is functional when used on coated abrasives. It functions to conceal imperfections like cracking and streaking.

## **2. 3M Admits it Uses Purple for Color Coding.**

3M's Trial Brief argument that its color coding scheme does not establish functionality of its alleged purple mark is unpersuasive. 3M admits several times that it color codes its SandBlaster coated abrasives, film-backed and non-woven multi-flex coated abrasives. (3M TB 41-44).

With respect to the SandBlaster product, 3M specifically admitted that "color would help [the customers] navigate and choose the specific product for [the] particular application..." and its research revealed that "DIY customers would find color useful in choosing a product for a particular hand sanding application" (3M TB 42); based on its own market research, it developed the SandBlaster line of hand sanding products for which particular uses would be designated by different colors (3M TB 42); 3M initially chose purple as the color used to designate one product (3M TB 42); and now uses maroon in place of purple in its SandBlaster color coding scheme (3M TB 42).

3M's explanation of its "mistake"(3M TB 43, 44) to use purple in a functional color coding system after deciding to secure a trademark registration for purple does not change the facts. Color, including purple, is used for a functional purpose. Color coding different applications for products in the coated abrasive industry is done by 3M, SG, and others (SG TB 11-12). 3M's research reveals customers find color useful in distinguishing sanding applications. 3M continues to use purplish colors like maroon, and a dark color 3M calls "purple" in connection with color coding its multi-flex abrasive sheets (SG TB Ex. 27 at 3M 04914) to designate the use of its coated abrasives. 3M's admissions provide the Board with further support that purple is functional; it is used in color coding schemes, and 3M color codes with purple and other colors.

3M argues that its use of color coding on film-backed and non-woven multi-flex coated abrasives should not be considered as evidence that 3M uses color coding schemes for coated abrasives (3M TB 45-46). 3M admits that it color codes its coated abrasives. (3M TB 45). It denies it color codes cloth or paper-backed product. (3M TB 45). 3M argues that the products at issue are not *all* coated abrasives, but *just* cloth and paper-backed coated abrasives (3M TB 45-46). The Board should not draw such a forced

and self-serving distinction among coated abrasives because the consuming public does not draw such a distinction, and 3M does not draw any such distinction in the real world.

3M markets and advertises all coated abrasives together. Cloth, paper and film-backed, and non-woven multi-flex products all are sold in the same catalogs. (SG TB Exs. 27, 36). Cloth, paper and film-backed, and non-woven multi-flex products are used in the same industries (SG TB Exs. 5, 23, 25, 36). 3M's admits that cloth, paper and film-backed, and non-woven multi-flex coated abrasives are used in working on the same surfaces and may be used sequentially (SG TB Exs. 5, 23, 25, 36).

3M cannot escape the consequences of its use of purple in color coding coated abrasives by claiming that the coated abrasives it color codes with purple are different than the coated abrasives for which it seeks a purple trademark. The relevant public makes no such distinction, nor does 3M in its marketing, and neither should the Board.

**3. 3M Does Not Deny that Some of its Coated Abrasives are Purple as a Result of the Manufacturing Process.**

3M suggests that there are too many variables, and too many possible resulting colors as a result of the manufacturing process, for purple to be considered functional *even if* purple and other purplish colors result from the manufacturing process and affect the cost or quality of the product (3M TB 37). This is contrary to the law. See, R.L. Winston Rod Co. v. Sage Mfg. Co., 838 F.Supp. 1396 (D. Mont. 1993).

3M claims that many of the products that SG cites as being purple because of the manufacturing process (such as T247, Premium Red, and R228) are not purple but rather black with a purple hue, reddish maroon, or maroon. (3M TB 38). The products are purple. While the products listed by 3M may have been *described* by various people differently, it is the *perception* of the color that matters, not what one person calls it. Two people may see the same color and one calls it maroon, one purple. Color names are subjective. (SG TB Ex. 2 at 55). The name does not change the shade.

SG's expert evidence that purple colors naturally occur as a result of the manufacturing process was uncontroverted by 3M or any 3M expert. 3M, SG and others commonly dye their products, but SG

also makes products, such as the R228, that it sells in their naturally occurring purple color (SG TB 8-9, 38). If SG is forced to change its formulation of the R228 product because it is naturally purple, SG and its customers will be significantly hindered by expense and delay (SG TB, Ex. 17; SG TB, App. 6 at 57-59).

3M states that it dyes its products to achieve the purple color but curiously does not identify the natural color of its products before they are dyed (3M TB 35-39). It may be presumed that some 3M product is naturally close to the same purple as SG's R228 product. 3M would dye its naturally purple or purplish products a darker purple for conformity, to conceal streaking and mask other imperfections. There is no indication that 3M added dye to its products for any purpose other than for functional reasons in 1989. (3M TB 5) In fact, 3M never claimed purple as a trademark until after the 761D product was on the market for several years (3M TB 5-6).

**4. 3M Cites No Legal Authority To Support its Claim that Purple is Not Functional.**

Virtually all the cases on which 3M relies to support its claim that purple for coated abrasives is not functional found the color in the respective cases to be functional for the respective goods. See, Brunswick, 35 F.3d at 1532; Ferris, 59 U.S.P.Q.2d at 1591; Leight, 39 U.S.P.Q.2d at 1060; Kasco Corp. v. Southern Saw Service Inc., 27 U.S.P.Q.2d 1501, 1505 (TTAB 1993); RL Winston, 838 F.Supp. at 1402; Spraying Systems Co. v. Delavan, Inc., 762 F.Supp. 772, 781 (N.D. Ill. 1991). In re Owens-Corning, 774 F.2d at 1116 is the only case 3M cites that found color not functional for the goods at issue. The facts in this case are markedly different from Owens-Corning.

3M correctly notes that there are "countless different variables that can impact the resultant color of a coated abrasive." (3M TB 38). SG agrees, "colors of coated abrasives range from white to black and almost every color in between, depending on the components and processes used." (SG TB 8). 3M also admits that it and SG consistently add dye to their products. (3M TB 37, 39). 3M's admissions distinguish this case from Owens-Corning. In Owens-Corning the insulation industry produced insulation that was always yellow-white because yellow-white was the natural color that resulted from the

manufacturing process. Owens-Corning, 774 F.2d at 1122. Owens-Corning took the arbitrary, unprecedented step of dyeing its product a different color, i.e., pink. Not only did pink never occur naturally in the manufacturing process, but no one in the industry ever used any color except yellow-white for insulation.

The Owens-Corning case provides the classic example of a non-functional color and is distinguishable in every way from this case. First, in Owens-Corning, insulation only came in one color and was the result of the manufacturing process. Owens-Corning, 774 F.2d at 1122. 3M admits that coated abrasives come in a wide range of colors, and purple is one color that naturally results from the manufacturing process (3M TB 38-39). Second, in Owens-Corning, everyone in the industry used the naturally occurring color because there was no functional reason to alter it. Id. Not only was Owens-Corning the only competitor to dye its product pink, it was the only one to dye its product at all. Id. Here, 3M admits that it and SG dye products. SG uses dye to conceal imperfections and meet customer demands (SG TB 41). 3M has admitted to using color, including purple, to color code its coated abrasives (3M TB 41-43).

There is no legal support for 3M's claim that purple is not functional when used on coated abrasives. Further, 3M's various admissions establish that this case is clearly distinguishable from, and the antithesis of, the Owens-Corning decision.

**C. 3M'S RELIANCE ON THE BOARD'S DECISION ON SG'S SUMMARY JUDGMENT MOTION IS MISPLACED**

The Board's decision of November 6, 2003 on the Summary Judgment motion is not relevant to the determination of any matter now at issue. At the time of the decision on that motion, the record was not fully developed; the sole purpose of the motion was to determine whether there were any issues of fact. The Board's decision on the Summary Judgment motion does not address whether 3M's mark is distinctive and/or functional, even on the record as it stood then.

Nor did the Board in its decision on the Summary Judgment motion endorse in any way the bizarre notion that a mark is defined by looking at the actual specimen filed rather than the drawing and

any associated description. See, TMEP §807 (“main purpose of the drawing is to provide notice of the nature of the mark sought to be registered”).

**D. 3M’S MISREPRESENTATIONS BETRAY THE WEAKNESS OF ITS CLAIM**

There are many instances where 3M’s Trial Brief clearly distorts the evidence of record.

Exemplary instances include the following:

Contrary to 3M’s assertion, SG has not focused primarily on sales figures prior to 3M’s 1996 launch of additional products (3M TB 27). Indeed, SG clearly references 1999 and 2000 sales figures and both companies saw growth year after year. (SG TB 16-17). Whether one looks at sales before 1996 or sales after that date, 3M’s sales of purple coated abrasives are a very small percent of 3M’s sales of coated abrasives, and an even more minute fraction of a percent of the sales of coated abrasives nationwide. Viewed in context, 3M’s sales are wholly insufficient to support an inference of acquired distinctiveness.

3M asserts that its advertising is not directed to niche markets. The evidence it made of record does not in any way support that assertion. Rather, it is evident that most of its advertising effort was directed to the woodworking industry where 3M’s sales have been greatly diminished by that industry’s decline in the U.S. (3M TB Exs. 3, 4, 22-25, 31-36). It is further evident from 3M’s own experts that 3M believed its claim to acquired distinctiveness was limited to the woodworking market. (SG TB, App. 26 at 31). The only advertising 3M has done directed to the general public was for the color-coded SandBlaster product where purple was used as part of a functional color-coding scheme, and that advertising was done once and not repeated (SG TB, Ex. 25 at Zelgart 19-A). 3M, further, has presented no evidence that other than the 1996 launch, it made any extraordinary effort to promote its purple colored product relative to the rest of the coated abrasives industry. It is, in fact, evident that 3M promotes its products in the same manner and to the same extent as SG and others in the industry (SG TB, App. 19 at 7-9).

To buttress its scant evidence of secondary meaning, 3M places great emphasis on the assertion that its customers order purple colored products by color although the record evidence does not support

this contention. 3M points to its print ads which say "Ask for it by color, not by name" and "If its purple its from 3M" as circumstantial evidence that its customers order this way (3M TB 1-2). The direct evidence does not substantiate this. 3M's only direct evidence on point is the testimony of one user, Mr. Hutton, who works on a very small number of highly specialized cars and orders a very small dollar amount of 3M product each year. (3M TB, App. 11 at 53, 56). Mr. Hutton testified that he uses primarily one "jobber" (distributor) from whom he orders coated abrasives and that jobber knows exactly what products Mr. Hutton uses. (3M TB, App. 11 at 27). It is not surprising that because of his long term relationship with one jobber, Mr. Hutton can order by a short-hand method. The unique relationship between Mr. Hutton and his jobber, however, is in no way indicative of how any other entity purchases, or how the vast majority of purchasers of coated abrasive products buy coated abrasives. In fact, the only other end-user who testified on behalf of 3M, Sprigg Lynn, did not testify that he ordered by color alone. Neither of 3M's two distributor witnesses support the "order by color" myth. Contrary to what 3M alleges, Mr. Kelley never testified that his customers ordered by color. When prompted by a leading question, Mr. Kelley said his customers referred to the product by color, not that his customers ordered by color. (3M TB, App. 5 at 23). Further, there is no indication that any such reference was not merely descriptive. A 3M product might properly be referred to in a non-trademark sense as a purple belt of a certain size and certain grit having a certain abrasive grain, or blend of grains. Mr. Wimer testified that you need the grit size and form, not the color, to order the product. (3M TB, App. 10 at 68-69). He elaborated saying that each step in the floor sanding process needs a different grit size and it is necessary to indicate the grit size when ordering (SG TB, App. 21 at 68-69). When Mr. Wimer orders products from 3M, he lists the product codes and grit sizes (SG TB, App. 21 at 68-69). He adamantly denied that he orders by color. (3M TB, App. 10 at 85). Instead, he refers to the 3M floor sanding products as the Regalite products, the Regalite belts and/or Regalite edger discs, and then indicates the appropriate grit size. (3M TB, App. 10 at 105). 3M's own employee, Mr. DeNuccio, testified that part numbers are used to order the purple products. He stated that 3M products contain part numbers on the back of each product "so that people can reference them when they talk to their distributor and order them." (3M TB,



App. 8 at 23). 3M states that the customer should "order by 3M product number" if they want the 961UZ and should also "specify quantity, grade and size." (3M TB, Ex. 7 at 3M 00132).

3M asserts that "virtually all of Moyco's purple-colored abrasives are film-backed." (3M TB 30). However, SG's brief at Exhibit 11 clearly shows that 5 of the 9 Moyco samples presented are paper-backed, not film, including one, SG 117, that 3M's expert, Mr. Turbyfill, misidentified as a 3M product (SG TB, Ex. 12; SG TB App. 8 at 67).

3M claims with no support that SG's Beauty Maid manufacturing plant in Canada services primarily the Canadian market (3M TB 30 fn. 17). This is simply not true. Although the plant is in Canada, the product is sold throughout the U.S. Beauty Maid converts the abrasive for its own use and for its customers, including those in the U.S. (R. Herron Test. Dep. at 41-45, herein attached as Exhibit K).

3M states that SG's witness, Mr. Herrin, called the SG T247 "black." (3M TB 2). In fact, Mr. Herrin stated: "I could say it's black. You can say it's a dark shadow of purple. There is a variety you would say with it." (3M TB App. 3 at 29). Further misrepresentation of Mr. Herrin's testimony occurs where 3M alleges that Mr. Herrin said that the SG R228 is a "shade of maroon." (3M TB 3). Mr. Herrin states, quite clearly, in response to 3M's question "Anything else, any other products that you maintain are purple?" that the R228 is "purple." It is only when 3M's counsel asks him whether it "could be a shade of maroon," that he says it is possible (3M TB App. 3 at 17-18).

3M alleges that Mr. Knowlton said that the Premier Red product is "black with a purple hue" or "red." (3M TB 3). Actually, Mr. Knowlton says that Premier Red is a line of products that comes "in a range of colors." (3M TB App. 4 at 38). Mr. Knowlton makes it clear that the line has a wide range of grit sizes and colors (3M TB App. 4 at 38). Purple is one of those colors, a purple that is very close in appearance to 3M's alleged purple (SG TB Exs. 4, 18).

3M charges that the non-woven abrasive sheets to which SG cites are "in fact, gray rather than purple." (3M TB 45). This is simply not true. Exhibit SG 27, 3M's Automotive Aftermarket catalog, shows Scotch-Brite Multi-Flex Abrasive Sheet Rolls which come in "maroon/purple." (See SG TB, Ex.

27 at 3M 04914). The two different colors of these sheets are gray (ultra fine grade) and maroon/purple for general purposes (SG TB, Ex. 27 at 3M 04914).

3M states that its purple products have been featured in various editorials and articles in trade publications, which "emphasize" the "deep purple" color and top performance characteristics..." (3M TB 11). Again, this is not true. No articles refer to a "deep purple," or any particular shade of the color.

### **III. SUMMARY**

3M has utterly failed to submit reliable, substantive evidence in support of its contentions that its alleged purple color is distinctive for coated abrasives and is not functional.

3M put forth no evidence to counter the facts that SG and others sell, and have since the 1950s sold, coated abrasives in various shades of purple, including deep or dark purples, and that a purple color results naturally during manufacturing as a result of the use of particular abrasive minerals and phenolic resin systems common in the industry.

3M has not shown that the "deep" or "dark" purple color of its coated abrasive products is used as a trademark. References to the color of its product are no more than descriptive, referring to an obvious visual attribute useful in describing the product by the relevant public. 3M's reliance on the testimony of four non-expert third party witnesses is wholly inadequate to support an inference of general recognition of the color as a mark. The four are not representative of the wide variety of end-users or purchasers.

3M's shifting claims make it difficult to address each of its arguments: the mark covers the 961UZ product; it covers the 745I product; the market in which it claims rights is woodworking; it claims rights in all markets; it has a trademark legend, but it puts the same legend on light purple and dark purple, on film, cloth and paper-backed products. So what can the legend signify? There is no evidence by which to ascertain what, if anything, the legend actually signifies to purchasers and consumers of coated abrasives. There is no inference of acquired distinctiveness that can be drawn from 3M's sales and advertising where 3M's sales are not as great as SG's sales of purple products, where its sales efforts have focused on niche markets, where its promotional figures are vague and shifting, and its promotion is not directed to the general purchasing and consuming relevant public.

3M's critique of SG's survey evidence is factually flawed. 3M's failure to submit any survey evidence in support of its own claim speaks volumes. Just as significant, the survey protocol is an accepted one, appropriate in the circumstances, and the methodology was one which in fact was designed to favor 3M, and still presented clear evidence that purple has no trademark significance.

3M's position on the issue of functionality is likewise deficient. 3M would with no basis at all have the Board simply ignore the functional use of color, and specifically the color purple, for coated abrasives. The Board need not ignore the use of color coding, and the use of dark colors to mask streaking in coated abrasives and otherwise minimize the visual impact of imperfections that may raise customer concerns.

In sum, there is no basis to find that the mark of 3M's application for the goods identified in the application has acquired secondary meaning. However the color is described, color, including the color purple, is functional when it appears on the surface of coated abrasives. 3M is not entitled to the registration it seeks. For the foregoing reasons, and for the reasons set forth in its main trial brief, SG respectfully submits that the registration of the mark of Application Serial No. 75/488,524 should be refused and this Opposition be sustained.

Respectfully submitted,

Dated: December 22 2005

By: Roberta Jacobs-Meadway  
Roberta Jacobs-Meadway  
Bernadine J. Munley  
BALLARD SPAHR ANDREWS & INGERSOLL, LLP  
1735 Market Street – 51<sup>st</sup> Floor  
Philadelphia, PA 19103  
(215) 665-8500

ATTORNEYS FOR OPPOSER

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the attached Opposer's Reply Brief and the Exhibits thereto filed with U.S. Trademark Trial and Appeal Board were served on *Roberta Horton, Esquire, Arnold and Porter, 555 Twelfth Street NW, Washington, DC 20004-1206*, counsel for the Applicant, on the date listed below via overnight mail delivery.

Dated: 12/22, 2005

  
\_\_\_\_\_  
Troy Larson